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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,224	06/25/2003	Thomas S. Murphy	3317.126 US1	4383

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EXAMINER	
DESAI, ANISH P	
ART UNIT	PAPER NUMBER
1794	

NOTIFICATION DATE	DELIVERY MODE
02/21/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/603,224	MURPHY ET AL.	
	Examiner	Art Unit	
	ANISH DESAI	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *29-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *29-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's arguments in response to the Office action dated 09/06/07 have been fully considered.

1. Claims 1-28 are cancelled. Claims 29-44 are new claims. Support for newly amended claim is found in the specification.

2. The objections to claims are withdrawn in view of the present amendment and response.

3. The 35 USC Section 102(b) rejections based on Murphy et al. (US 5,762,623) are withdrawn, because Murphy does not teach the porosity of the porous adhesive carrying fabric is greater than the porosity of the backing substrate as claimed in presently amended claim 30.

4. All other art rejections are maintained.

5. The obviousness type double patenting rejections are maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 29, 31-35, and 38-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schueler (US 2,740,403) alone, substantially as set forth in the previous Office Action.

Schueler discloses adhesive bandages for medical and surgical purpose (column 1, line15-16). The adhesive bandage of Schueler is a two-ply bandage containing a backing, which is made from a porous fabric and another thickness (known as carrier) made of an open mesh

fabric that is impregnated or coated with an adhesive in such manner that the fabric remains substantially porous (column 1, lines 22-33). The carrier of Schueler is adhered to one surface of the backing to form two-ply bandage (column 1, line 33-34). The examiner is equating the carrier of Schueler as an adhesive-carrying fabric as claimed and the porous backing of Schueler as a porous backing substrate as claimed. Additionally, Schueler discloses that the carrier layer (adhesive-carrying fabric) can be formed in a great variety of manners. It may be woven, knitted or otherwise formed to give an open-mesh fabric which is subjected to an impregnation treatment with the adhesive and then after the impregnation can also be given an additional coating on its outer surface and in any case in the result, so that by differential pressure treatment, striking off, doctoring, or otherwise, it still presents, although impregnated, a substantially porous structure (column 1 lines 56-65). With respect to the porous backing, Schueler discloses that the porous backing is a closely woven fabric having say thread count of 100 yarns to the inch with openings between the yarns of 0.005 inch. Thus, although the woven fabric is closely woven, it is pervious (column 2 lines 42-47). Further the backing of Schuler is elastic (column 1 line 28).

The difference between the claimed invention and the prior art of Schueler is that Schueler is silent with respect to teaching the fabric after application of adhesive having greater than about 60% of open area, the fabric after application of adhesive having an open area that is not more than about 10% to about 20% less than the open area of the fabric prior to the application of adhesive, the fabric prior to application of adhesive having in the range of about 50% to about 95% open area and after the application of adhesive having an open area that is not more than about 10% to about 20% less than the open area of the fabric prior to the application of adhesive, the porous backing substrate has greater than about 50% of open area, and adhesive

of the adhesive carrying fabric penetrates into about 25% to about 75% of the thickness of the porous backing. However, it is noted that Schueler discloses the general condition of the claims, specifically; Schueler discloses a two-ply bandage (article) having a porous backing substrate and a porous adhesive-carrying fabric that is applied to the backing substrate. Therefore, Schueler discloses general structure of Applicant's claimed article. Further the reference of Schueler and that of Applicant are in the same field of endeavor, namely in the field of breathable adhesive bandages. Additionally, throughout the Schueler reference, specifically at column 1 lines 30-35 and lines 55-65, column 2 lines 3-15 and lines 42-47, Schueler discloses that both the porous backing and the fabric that is impregnated with the adhesive should remain porous. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the workable ranges for porosity and optimize the porosity of the fabric and the backing such that the fabric after application of adhesive having greater than about 60% of open area, the fabric after application of adhesive having an open area that is not more than about 10% to about 20% less than the open area of the fabric prior to the application of adhesive, the fabric prior to application of adhesive having in the range of about 50% to about 95% open area and after the application of adhesive having an open area that is not more than about 10% to about 20% less than the open area of the fabric prior to the application of adhesive, the porous backing substrate has greater than about 50% of open area, and adhesive of the adhesive carrying fabric penetrates into about 25% to about 75% of the thickness of the porous backing, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233).

As to the claim limitation of the adhesive having sufficient internal cohesive strength such that the article is removable from a substrate without separation of the backing substrate and the adhesive carrying-fabric, it is noted that the structure of the product of Schueler and that of the Applicant is same. Specifically, the article of Schueler and that of Applicant comprises a porous substrate and an adhesive carrying fabric applied onto a porous substrate. Moreover, the end use of Applicant's article and that of Schueler is the same, namely in the field of adhesive bandages. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an adhesive bandage with an adhesive having sufficient internal cohesive strength such that it can be easily removed from skin without any pain or irritation.

7. Claims 30, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schueler et al. (US 2,740,403) in view of Murphy et al. (US 5,762,623).

The basis of this rejection remains substantially the same as set forth in the previous Office Action, except that the independent claim 30 is now addressed under this rejection due to the amendment to this claim. With respect to claim 30, the invention of Schueler as previously disclosed equally applies here. With respect to the newly amended claim limitation of the porosity of the adhesive fabric being greater than the porosity of the porous backing substrate, the upper ply or the backing 6 of Schueler has openings 7 with the size of the each opening being 0.0005 in and the lower ply or the carrier 8 (adhesive carrying fabric) of Schueler has openings wherein each opening has size of 0.01 in (see Figures 2-3 and column 2 lines 41-55). Further, the lower ply or carrier of Schueler is impregnated with an adhesive (column 2 lines 42-51). Thus, the porous adhesive carrying fabric of Schueler has a porosity greater than that of the backing substrate.

Schueler is silent with respect to teaching wherein the porous adhesive-carrying fabric has a thread count in at least one direction that is not more than 18 yarns per inch. However, Murphy teaches a laminated tape/bandage comprising a layer of transversely-spaced, longitudinally-extending elastic strands between a pair of outer layers, at least one of which is a warp-knitted (weft insertion) fabric oriented with knit yarns extending longitudinally and generally parallel to the orientation of the elastic strands (see abstract). Further Murphy teaches that the laminated tape/bandage is light, comfortable to wear, can be easily torn transversely by hand and when so torn tears cleanly substantially perpendicularly across the width of the tape/bandage (column 3, lines 19-25). Additionally Murphy discloses warp weft thread count of

18*16 (column 2, line 46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the warp-knitted (weft insertion) fabric of Murphy in the invention of Schueler as a carrier layer (adhesive-carrying fabric), motivated by the desire to create adhesive bandage that is light, comfortable to wear, and can be easily torn transversely by hand and when so torn tears cleanly substantially perpendicularly across the width of the adhesive bandage.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 29-44 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 95-107 of copending Application No. 11/204,736. Although the conflicting claims are not identical, they are not patentably

distinct from each other because claims 29-44 encompass the same subject matter as disclosed by claims 1-5 and 95-107 of S/N 11/204,736.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

9. Applicant's arguments filed on 12/05/07 have been fully considered but they are not persuasive. The Examiner again thanks Applicant for in depth analysis of Schueler reference.

10. It is noted that Applicant has continued to maintain his/her position with respect to the Examiner's obviousness rejection based on Schueler (US 2,740,403), and tried to clarify his/her position with respect to the Examiner's comments with respect to the declaration filled by Mr. Michael C. Miller (Mr. Miller) on 06/18/07.

Applicant does not agree with the Examiner's position that he/she can not use drawings in Schueler reference in calculating the diameter of the yarns of the adhesive carrying fabric, which in turn is used to calculate the porosity of the carrier fabric (adhesive carrying fabric) of Schueler **before** the application of an adhesive. According to Applicant, Schueler does state that the lower fabric (adhesive carrying fabric) is "similar fabric but more openly woven so that the spaces between the yarns leave openings 9 of say some 0.01" side." (column 2 lines 48-50). Further, no information is given in Schueler that could be used to calculate yarn diameter. According to Applicant where the comparison is not identical with the reference disclosure, deviations therefrom should be explained, and if not explained should be noted and evaluated, and if significant explanation should be required (MPEP 7160.02(e)). Further Applicant asserts

that the teachings of Schueler are so general that it is impossible to determine what levels of porosity are even contemplated.

The Examiner respectfully disagrees with Applicant. It is respectfully submitted that even if assuming the argument that the carrier (adhesive carrying fabric) of Schueler reference has lower porosity before the adhesive is applied to it, to the Examiner, Applicant is relying on a narrower teaching of Schueler and ignoring the broader teaching of Schueler. As previously noted, Schueler discloses general conditions of the presently claimed invention. Specifically, Schueler discloses a porous backing substrate and an adhesive-carrying fabric that is applied to the porous backing substrate as claimed. Additionally, as previously stated Schueler discloses that care should be taken so that the carrier (adhesive carrying fabric) would maintain its porosity after it is impregnated with the adhesive (see column 1 lines 57-66 and column 2 lines 12-15). Moreover, the invention of Schueler and that of the presently claimed invention have same utility (i.e. adhesive bandage). Breathability which is related to the porosity is highly desirable in the adhesive bandages, since Schueler discloses general conditions of the presently claimed invention as set forth above, discovering the optimum or workable ranges of the porosity involves only routine skill in the art (*In re Aller*, 105 USPQ 233) absent some unexpected result.

Applicant does not agree with the Examiner's position that Mr. Miller's declaration does not compare the claimed invention to the closest prior art of Schueler, because Mr. Miller did not use the same fabric (carrier) as that is disclosed by Schueler. Applicant asserts that as stated in the declaration Mr. Miller attempted to obtain woven cotton fabric samples with about 67 yarns per inch in both the warp and weft directions as taught by Schueler, but such a fabric was not commercially available. Thus, Mr. Miller used a woven cotton fabric having 75 yarns per inch

in the warp direction and 44 yarns per inch in the weft direction. According to Applicant "As stated supra, legal precedent allows for deviations so long as they are explained. *In re Finley*, 174 F.2d 130; *In re Armstrong*, 280 F.2d 132.". This is not found to be persuasive because while Mr. Miller used different fabric than what is described by Schueler, it is not clear as to where in the declaration he has explained the deviations as asserted by Applicant. Additionally, as set forth in the previous Office Action, the declaration generally states that a water based pressure sensitive adhesive was used and that the materials were oven-dried and placed on a release paper. However, the declaration does not disclose as to what type of adhesive was used (i.e. composition) or what conditions are used to dry the samples. Further it is not clear as to whether a thicker adhesive or a thinner adhesive (i.e. viscosity) used to coat the samples (see page 11 of 09/06/07 Office Action).

11. As to the art rejections based on Schueler in view of Murphy et al. (US 5,762,623), it is noted that Applicant generally disagrees with the Examiner's rejection, and incorporates the same arguments as set forth with Schueler in his/her rebuttal. Therefore, the Examiner has noting more to add but what has been said above with respect to Schueler reference.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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